

**REMARKS**

Claims 52 through 54 are currently pending in the application.

This amendment is in response to the final Office Action of August 5, 2003 and the Advisory Action of October 16, 2003.

**Correction of the Abstract of the Disclosure**

Applicants have deleted lines 1 through 2 as requested by the Examiner.

**Information Disclosure Statement(s)**

Applicants note the filing of an Information Disclosure Statement herein on May 30, 2003 and note that a copy of the PTO-1449 was not returned with the outstanding Office Action. Applicants respectfully request that the information cited on the PTO-1449 be made of record herein.

**35 U.S.C. § 102(b) Rejections**

**Anticipation Rejection Based on Sinclair (U.S. Patent 5,984,694)**

Claim 52 is rejected under 35 U.S.C. § 102(e) as being anticipated by Sinclair (U.S. Patent 5,984,694).

Applicants submit that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants assert that the presently claimed invention is not anticipated by the Sinclair reference because the Sinclair reference does not and cannot identically describe, either expressly or inherently, the elements of the presently claimed invention of presently amended independent claim 52. Applicants submit that the Sinclair reference has no description whatsoever of the elements of the presently claimed invention calling for 'forming a contact head from a conductive material as at least one member of a socket contact having at least two members

forming portions thereof”, “forming a contact body from a semiconductive material configured to be electrically conductive as a member of a socket contact having at least two members forming portions thereof:, and “joining said contact head and said contact body forming a socket contact having at least two members forming portions thereof”.

It is asserted in the Final Rejection that Sinclair discloses a “semiconductive material contact body (14), a contact head (70), joined package (Fig. 10).” (Final Rejection Dated August 5, 2003). Applicants respectfully disagree. Element 14 disclosed in Sinclair is a semiconductor device 14. (Sinclair, column 5, lines 64-65). Element 70 of Sinclair is a dual contact and comprises a pair of cantilevered opposing arms 78. (Sinclair, column 7, lines 44-46). Figure 10, referred to in the Office Action, describes the cantilevered opposing arms 78 contacting a ball lead 16 of a ball grid array. (Sinclair, FIG. 10).

The term “socket contact” in the preamble of independent claim 52 recites a structural limitation that must be treated as a claim limitation and given patentable weight. (See, M.P.E.P. § 2111.02 citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)). The plain meaning of the term “socket” is “an opening or hollow that forms a holder for something.” (Webster’s Third New International Dictionary, USA, 1986). Because the term “socket” modifies contact, it refers to a contact having a socket or an opening or hollow configured to hold another member such as external electrical device’s electrical contacts.

Assuming for the sake of argument that the cantilevered opposing arms 78 of Sinclair inherently describes forming a contact head from a conductive material, it lacks still lacks a contact body from a semiconductive material. If the cantilevered opposing arms 78 have a contact body at all, it must be element 84 of Sinclair which is ball lead 84. However, element 84 is not a semiconductive material as required by claim 52.

If semiconductor device 14 of Sinclair is considered for the sake of argument to describe forming a contact body from a semiconductor material configured to be electrically conductive, it lacks a socket contact head formed from a conductive material. Ball lead 16 of Sinclair lacks the required socket type structure as required by the preamble of claim 52.

Furthermore, Applicants submit that FIG. 10 does not disclose joining the contact head and the contact body as required by claim 52. If element 78 is considered to be a contact head as Applicants believe that is being considered, it cannot fairly be asserted that element 78 is joined to a element 14 which is relied upon in the rejection as a contact body. FIG. 10 of Sinclair does not inherently describe joining element 14 (a semiconductor device) and element 78. FIG. 10 does not disclose joining element 78 and element 14 because they lack a unifying structure. Applicants submit that the plain meaning of joining is "to unify or merge." (The Oxford Desk Dictionary and Thesaurus American Edition, USA, 1997). On the other hand, element 78 appears to be joined to element 16 (a ball lead of a BGA).

Therefore, for the reasons set forth hereinabove, presently amended independent claim 52 is not anticipated by Sinclair because Sinclair does not identically describe, either expressly or inherently, every element of the presently claimed invention. Furthermore, dependent claims 53 and 54 are not anticipated because they depend from novel independent claim 54.

### **35 U.S.C. § 103(a) Rejections**

Obviousness Rejection Based on Sinclair (U.S. Patent 5,984,694) in view of Hirano et al. (U.S. Patent 5,283,459) and further in view of Grabbe (U.S. Patent 5,173,055)

Claims 53 and 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sinclair (U.S. Patent 5,984,694) in view of Hirano et al. (U.S. Patent 5,283,459) and further in view of Grabbe (U.S. Patent 5,173,055). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants further submit that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants believe that the claimed invention is clearly distinguishable over the cited prior art. Applicants assert that any proposed combination of the cited prior art fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed inventions of presently amended claims 52 through 54 because any combination of the cited prior art, at the very least, fails to teach or suggest all the claim limitations of the presently claimed inventions. For instance, Applicants assert that any combination of the cited prior art fails to teach or suggest the claim limitations of the presently claimed invention calling for 'forming a contact head from a conductive material as at least one member of a socket contact having at least two members forming portions thereof', "forming a contact body from a semiconductive material configured to be electrically conductive as a member of a socket contact having at least two members forming portions thereof", "joining said contact head and said contact body forming a socket contact having at least two members forming portions thereof", "said forming a contact head comprises stamping a metal element as at least one member of a socket contact having at least two members forming portions thereof", "said forming a contact body comprises etching silicon as at least one member of a socket contact having at least two members forming portions thereof", "said joining said contact head and said contact body further comprises adhering said contact head onto said contact body forming a socket contact having at least two members forming portions thereof", and "said joining said contact head and said contact body further comprises depositing a metal over a silicon surface for a socket contact having at least two members forming portions thereof ". Applicants submit that any combination of the cited prior art contains no such teachings or suggestions whatsoever to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed inventions of amended claims 52 through 54.

Additionally, Applicants respectfully submit that the Office Action has not provided a convincing line of reasoning to combine the teachings of Hirano and Grabbe and is using hindsight to reconstruct the presently claimed invention. The Office Action has not provided any reason, other than possible relying on Applicants' disclosure, to modify Sinclair by stamping the contact head from a metal element as required by claim 53.

Furthermore, elements 16 and 17 of Hirano are apertures or cavities. (Hirano, column 1, lines 53-58). Applicants are unsure if the Office Action is asserting that one of ordinary skill in the art would apply a metal to the inside of apertures 16 and 17. Apertures 16 and 17 in Hirano do not appear to be coated with a metal. Thus, there is no motivation to deposit a metal to the inside of the apertures. Therefore, the combination of the cited prior art cannot and does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed invention because there is no suggestion whatsoever in the cited prior art for any combination thereof.

In summary, Applicants submit that claims 52 through 54 are clearly allowable over the cited prior art.

Applicants request entry of this amendment, the allowance of claims 52 through 54, and the case passed for issue.

Respectfully submitted,



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